

**REMARKS**

Applicants appreciate the withdrawal of all rejections set forth in the previous Office Action dated May 1, 2008. Reconsideration and withdrawal of the new grounds of rejections are respectfully requested in view of the foregoing amendments and the following comments.

Applicants respectfully traverse the previous rejections of claims 1-2, 10 and 13 under 35 U.S.C. 102 (b) "as being anticipated by Grau (WO 03/060256) with evidence by Grau (U.S. Patent 2005/0115181) and the publication by Don Bollinger, Mixing It Up, August/September 2003, Hardwood Floors, pp. 49-55 (herein after referred to as Bollinger)".

Initially, applicants question whether the Examiner understands what constitutes "anticipation" within the meaning of 35 U.S.C. 102 (b), as alleged in the Office Action.

The Office has promulgated guidelines to the examining corp in the form of MPEP Section 2131.01 which states "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference (citations omitted)". While multiple references may be cited in making rejections under 35 U.S.C. Section 102, the commissioner further explains in MPEP Sections 2131.01 that the extra references are proper when they are cited to:

- (a) prove the primary reference contains a "enabling disclosure;"
- (b) explain the meaning of a term used in the primary reference;
- (c) shows that a characteristic not disclosed and the reference is inherent (emphasis added).

The Examiner does not identify any of these purposes in the citation of the additional two documents mentioned in the rejection. Moreover, applicants respectfully point out that Grau (U.S. Patent 2005/0115181) is not "prior art" under 35 U.S.C. 102 (b), as it was not published until June 2, 2005, subsequent to applicants effective filing (the filing date of applicants PCT application on November 16, 2004). Thus, Grau

(U.S 2005/0115181) cannot be used a “evidence” for the teaching of Grau (WO 03/060256). Moreover, the English language abstract on the WO publication of Grau indicates that the tiles (7) are a series of identical and rigid/slab framing modules (1, 8). Moreover, as is best understood that Grau (WO 03/060256) comprise vertical lateral flanges 5 between panels and thus does not have upper decorative surface, which are different and “independently consisting of a decorative material selected from the group consisting of a thermosetting composite, a thermoplastic composite, an elastomeric foil, a thermoplastic foil, a fabric, a mineral and a mineral composite” as now recited in independent claim 1. Nor does the system comprise a plurality of panels wherein the upper decorative surface of one panel consists of a thermosetting composite and at least one other panel consist of an upper decorative surface selected from the group consisting of a thermoplastic composite, elastomeric foil, a thermoplastic foil, a fabric, a mineral and a mineral composite, wherein the elastomeric foil is selected from the group consisting of thermoplastic elastomer, synthetic rubber and natural rubber. While Bollinger is a secondary reference which teaches that combining various materials such as wood, metal, stone, were known at the time of applicant’s invention, such does not make that teaching “inherent” in the Grau WO publication, and certainly does not meet the other limitations of applicants claims. For example, Grau WO mentions “tile” which could be “ceramic” and thus not inherent from the “wood, metal, stone” of Bollinger. Bollinger does not teach or even suggest a flooring system comprising a plurality of flooring panels. What it appears that Bollinger is doing is taking natural materials such as stone, metal, or wood and juxtaposes them, as Bollinger never talks about panels having a carrying panel and an upper decorative surface. Thus, there is nothing in the teachings of Bollinger which makes it “inherent” for Grau WO to act as an anticipatory reference. Accordingly, the rejection of the claims under 35 U.S.C. 102 (b), must fail.

The same deficiencies noted above with regard to the proposed combination of the Grau WO publication, the Grau U.S. publication, and Bollinger, also applied to the alternative rejections of claims 1, 4-6, 8-10 and 13, allegedly under 35 U.S.C. 102 (b), as anticipated by Hansson et al. (U.S. 6,465,046), with “evidence” provided by the publication of Bollinger. Again Bollinger clearly lacks any teaching of “panels” and certainly has no teaching of a panel system wherein carrying panels having edges for joining are provided with upper decorative surfaces of the materials as specified in the claims. Thus, there is no “inherency” shown by the Bollinger reference in Hansson.

While the Examiner correctly notes that Hansson ‘046, has a decorative surface element “such as a map that extends across several panels thus providing for different aesthetic properties on the different panels since each panel has a different portion of the map” such does not at all teach the claimed invention. Rather, applicant’s system comprises a plurality of panels wherein each panel comprises a carrying panel and an upper decorative surface, and the decorative surfaces are specified in each of independent claims 1 and 10. Thus, contrary to the Examiner’s allegations that claims 1 and 10 did not require the decoration on the upper surfaces to be different, applicant respectfully submits that the previous claims did exactly that by specifying that “at least two of the decorative surface of the flooring system being different and selected from the group consisting of...”. Thus, there is nothing in the proposed combination that would have made it “inherent” in Hansson even if one were to rely on the Bollinger teaching, and thus the rejection must also fail as one of anticipation.

Reconsider of the still alternative rejection of claims 1, 10, and 13 under 35 U.S.C. 102 (e), as anticipated by Sjoberg (U.S. 2004/0170812), “with evidence by the publication of Bollinger”, fails for the same reasons. While the panels of Sjoberg ‘812, have different aesthetic appearances they do not comprise different materials selected from the recited groups of any of the independent claims.

As the deficiencies of Bollinger as not even relating to a panel system has been expressed above, there is no "inherency" in Sjoberg of the claimed invention.

The alternative rejection over the same combination of references for "obviousness" under 35 U.S.C. 103 (a), must also fail.

As noted above, Sjoberg clearly does not teach a system of panels having upper decorative surfaces formed of two different materials selected from the recited markush group. Bollinger does not even teach a system of panels. Thus, the proposed combination of references does not establish a case of obviousness for the claimed invention. Withdrawal of both 102 and 103 rejections are therefore respectfully requested.

Withdrawal of all the 35 U.S.C. 103 (a), rejections set forth in paragraph numbers 7-16, from pages 8-20 of the Office Action, is requested as all fail to establish a prima facie case of obviousness for the claimed invention.

The Examiner apparently does not even recognize the fact that Bollinger does not even teach a flooring system comprised of a plurality of panels. As can best be understood from the Bollinger disclosure, Bollinger takes natural materials, such as pieces of wood, metal, stone, etc... and juxtaposes them together so as to create an aesthetic effect. There is no teaching of creating a system of panels, and certainly not of a panel system comprising a carrying panel with an upper decorative surface as instantly claimed. While the Examiner alleges, for example, with regards to Martensson '547, that the upper decorative surfaces comprise panels with at least two of the decorative surfaces being a thermoplastic composite, or a thermoplastic foil, such is not correct. Moreover, the claimed invention requires that the panels comprise two different decorative surfaces. Martensson '547, at the cited portion relied upon by the Examiner (column 3, lines 23-30, and figure 2 number 1) proposed alternative decorative surfaces, they do not provide a flooring system wherein those different decorative surface are part of a single flooring system. This is apparently conceded by the Examiner in this respect in the middle of page 9 of the Office Action, wherein it is said that

Martensson '547 "however, fails to expressly disclose at least one panel differing in at least one of the aesthetic or mechanically properties different from another panel of said system". Actually, it is not only merely different, but different in the claimed respect that is missing from the teachings of Martensson '547, which are not corrected by Sjoberg '812, nor Bollinger for the reasons set forth above.

The numerous alternative rejections are an indication that the Examiner has failed to establish a prima facie case of obviousness for the claimed invention. For example, in the alternative rejection of Grau (WO) with "evidence" by Grau (U.S. 2005/0115181), Bollinger and Hansson '046, the Examiner erroneously again cites Grau (U.S. 2005/0115181) and Bollinger as "evidence" to apparently establish the presumed "inherency" of Grau (WO) publication.

However as noted in the first rejection discussed above, there is not inherency in the Grau (WO) publication in the basic teachings of the claimed invention. For example, could Grau only adopt the metal and wood aspects of Bollinger? Neither are within the claimed invention, but does that not destroy "inherency" by reducing the choices to one of "probabilities". Any choice, even a choice of high probabilities does not equal inherency. Thus, the combination with Hansson '046 would be needed to establish a prima facie case of obviousness.

However, the Examiner, in citing Hansson '046 suggests that "selecting one of the above polymeric or metal materials for the panel surfaces would have been obvious depending on whether the panels are used outdoors, indoors, subject to heavy traffic, no traffic, consumer preference based on appearance or cost" all mimics the disclosure of applicants specification that is in no way supported by the teachings of the document itself. Thus the Examiner sole basis for the so called holding of "obviousness" is not based on the prior art, nor even the knowledge of the art (which is not even attempted to be satisfied by the Examiner), but rather on a hindsight reconstruction utilizing the objects of applicants own

specification as the basis for the obviousness conclusion. Such does not establish a prima facie case under 35 U.S.C. 103 (a). However, the instant claims do not require the presence of metal and thus the claimed invention is more particularly removed from the allegations of obviousness as set forth in the Office Action.

There is still a further rejection under 35 U.S.C. 103 (a), of claims 14-16, as unpatentable over Grau (WO) as “evidenced” by Grau (U.S. Patent 2005/0115181), and Bollinger in view of Sjoberg (WO ‘906), still fails to teach or make obvious the claimed invention. The “evidence” of Grau (U.S. Patent 2005/0115181) and Bollinger have been shown above not to make it “inherent” in Grau (WO) to arrive at a flooring system of the type claimed. While it is said that Sjoberg (‘906) flooring panels made of elastomeric foil which comprises thermoplastic elastomers (See p. 2, II. 15-22.) for the purpose of providing a flooring panel that is resistant to abrasion, chemicals and sound (See p. 1, II. 1-7), this fact does not make obvious the claimed invention.

In Sjoberg (‘906) the existence of the elastomeric foil which comprises thermoplastic elastomers is between the upper decorative surface and a carrying core (See for example p. 1 lines 18-25). Thus, the elastomeric foil which comprises thermoplastic elastomers in Sjoberg (‘906) is not the decorative surface claimed by the claims in the application. Thus, there is nothing in the proposed combination of references that would make claims 14-16 “obvious” within the since of 35 U.S.C. 103 (a).

The rejection of claim 17, over the same references applied to claim 1 above, Grau (WO) “with evidence” by Grau (U.S. Patent 2005/0115181) and Bollinger, or Sjoberg ‘812, in view of patent to Bettinger (U.S. Patent 3,811, 237), with “evidence” by Bollinger does not establish a prima facie case of obviousness. The deficiencies in the proposed combination of the WO Grau with the “evidence” of the Grau U.S. publication and Bollinger have been discussed above, which arguments are repeated herein. The deficiencies of Sjoberg ‘812 have been partially acknowledged by the Examiner at the first two lines on page

14 of the Office Action. However, Sjoberg also does not teach a system of flooring panels wherein the surface which comprises the decorative surface of one floor panel is made of a material different from another floor panel as expressly required by claim 17. While Bettinger is cited only to distinguish different types of carpets, such is not the claimed invention and the combination with Sjoberg '812 would not result in a prima facie case of obviousness. As noted hereinabove Bollinger does not even teach a system of floor panels, and thus his disclosure adds nothing to the proposed combination of Sjoberg '812 and Bettinger '237, in order to establish a prima facie case of obviousness. Withdrawal of the rejection is therefore respectfully requested.

There is still the alternative rejections with various reorganization of Grau (WO), Grau (U.S. Patent 2005/0115181), Bollinger and Sjoberg (WO '906) or Sjoberg (WO '812), Bettinger and Martensson and Bollinger, none of which establish a prima facie case of obviousness for independent claims 1 and 10, nor dependent claims 18-20 as discussed above.

The even still further rejection of claims 1, 10 and 12 under 35 U.S.C. 103 (a), as being unpatentable over Pervan (U.S. Patent 2002/0007609) in view of Sjoberg '812 with "evidence" by Bollinger also does not establish a prima facie case of obviousness. While the Examiner has alleged that each panel of Pervan '609 "is provided with an upper decorative surface or a metal sheet (See paragraph 9 and 62 in FIG -6 panel #1 and panel # 1') such is a misreading of the teaching of Pervan. Pervan only uses metal as part of strips 6 to join the panels together, See paragraph [0009], in fact numeral 1 and 1' are the respective boards and not the surfaces as alleged by the Examiner. It goes without saying that strips 6 are located at the bottom, not the upper decorative surface of a floor board (See Figs 1a-1c, 2a-2c, paragraph [0009] and [ 0010]. Thus the Examiner's misreading of the teachings of the Pervan U.S. Patent publication negate any possible of establishing a prima facie case of obviousness of claims 1, 10, and 12 under 35 U.S.C. 103 (a).

Reconsideration of the previous rejections of claims 1 and 10 under 35 U.S.C. 103 (a), as being unpatentable over Sjoberg (WO) publication in view of Sjoberg (U.S.) publication with "evidence" by Bollinger is respectfully requested.

The Examiner acknowledges that Sjoberg '906 fails to expressly disclose "at least one panel differing in at least one of the aesthetic and mechanical properties from another panel of said system". While applicant respectfully submit that the previous claims 1 and 10 also required that the upper decorative surfaces of boards be different, the Examiner has refused to consider such limitation. Therefore, in view of the refusal to consider the limitation, the Examiner cannot establish a prima face case of obviousness for the claimed invention. Accordingly, withdrawal of the rejections is respectfully requested.

The rejection of claim 20 under 35 U.S.C. 103 (a), as being unpatentable over Sjoberg (U.S.) publication in view of Bettinger '237 and Sjoberg (WO) publication with "evidence" by Bollinger is respectfully traversed. As noted above, applicant respectfully traverses the allegations that Sjoberg '812 and Bettinger '237 teaches system discussed above, but expressly recognize the Examiner's concession that they each "fail to expressly disclose where the floor also comprises a elastomeric foil". However, applicant does not allege that the floor "comprises an elastomeric foil", but rather that the upper decorative surface is an elastomeric foil. Sjoberg '906 does not teach such a limitation, but rather uses an elastomeric foil "between" the upper decorative surface, and the core of the panel. See the disclosure on page 1, lines 18-25 of Sjoberg '906.

Thus, the Examiner has simply missed the inventive concept of the claimed invention, and in fact has failed to understand the requirements of anticipation under 35 U.S.C. 102 (b) as well as the requirements for "obviousness" under 35 U.S.C. 103 (a). Accordingly, withdrawal of all rejections and passage of the application to issue without further delay is respectfully requested.



For the foregoing reasons, favorable reconsideration and withdrawal of the previous rejection and passage of the application to issue are respectfully requested.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 14-1437, under Order No. 8688.049.US0000.

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Respectfully submitted,



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